Appl. No. 10/661,052
Amdt. dated July 28, 2008
Reply to Office Action of March 27, 2008

PATENT

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 27, 2008. Claims 1-83 were pending in the present application. This Amendment amends claims 61, 69, and 78, without adding or canceling any claims, leaving pending in the application claims 1-83. Reconsideration of the rejected claims is respectfully requested.

I.   Rejection under §101

Claims 61-83 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, these claims are rejected as reciting a "computer-readable medium" which, when read broadly, allegedly includes wireless networks and wireless signals (OA p. 3). Although Applicants do not agree with the rejection, these claims have been amended to instead recite a "computer-readable storage medium", which as defined in the specification does not include a wireless signal or other such transmission medium. Accordingly, Applicants respectfully request that the rejections with respect to claims 61-83 be withdrawn.

II.   Rejection under 35 U.S.C. §103

Claims 1-5, 7-11, 12-16, 18-21, 31-35, 37-51, 61-72, and 74-77 are rejected under 35 U.S.C. §103(a) as being obvious over *Jasinschi* (US Publication No. 2002/0164151) in view of *Narayanaswami* (US Publication No. 2003/0011684). Applicants respectfully submit that these references do not teach or suggest each element of these claims.

As discussed in MPEP §2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Simply combining

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references showing models and libraries is not enough to make a case for obviousness, and even though the *KSR v. Teleflex* decision has given flexibility beyond the teaching / suggestion / motivation test, the mere fact that portions of elements may be recited in these references is not enough to prove obviousness without some teaching or suggestion as to how the combination could be implemented to result in the claims as recited. In particular, the mere fact that the image authenticity verification process of *Narayanaswami* can, for sake of argument, be used with the automatic index and table of contents generation system of *Jasinchi* does not mean that the specific combination and recitation of claim 1 is obvious.

For example, as discussed previously of record, *Jasinschi* does not involve comparing the recorded information to a source document that is "separate from the recorded information," as recited in Applicants' claim 1, as *Jasinschi* segments a video automatically by, in certain stages, comparing portions of a presentation to other portions of the same presentation, such as to distinguish lecture video clips from video of the lecturer. Since *Jasinschi* is comparing portions of the same presentation, there would be no obvious reason to determine whether one portion was authentic and the other was not authentic. Even if, for sake of argument and well beyond the teachings of *Jasinschi*, one would be motivated to use the image authentication approach of *Narayanaswami* with *Jasinschi* to determine whether a portion of the video was authentic, there is no teaching or suggestion as to how to determine which portion is authentic if the portions are different. If the video is compared to another copy of the video for purposes of determining authenticity, for which there is no teaching, suggestion, or motivation in either reference, there is still no teaching as to how to accomplish this for video, as a recording of source material during a presentation would have different color values and other attributes, and there is no teaching or suggestion of how this information could then be extracted and compared. Further, there is no teaching or suggestions as to actions being dependent upon the particular portion of the video being analyzed - either the portions are the same or they are not.

As discussed, *Narayanaswami* teaches automatically watermarking images for purposes of determining authenticity of the images (see for example paragraph [0013]). It is respectfully submitted that this is non-analogous art, or at least that a person trying to index video or perform

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a similar task using the *Jasinschi* approach would have no motivation to look to an image authenticity verification process. The image authenticity process would not help to index portions of a video, or provide any other help for the process of *Jasinschi*. Further, regarding Applicants' claims, such an authentication process would not help to determine whether portions of separate documents correspond to the same material, only whether documents that are assumed to correspond to the same material are in fact the same or if one has been altered relative to the other. A combination of the image authentication process of *Narayanaswami* with the video indexing process of *Jasinschi* would not arrive at the subject matter of Applicants' claim 1, or the claims that depend therefrom, and would not provide the advantages of that subject matter. The other claims recite limitations that similarly are not rendered obvious by these references.

Applicants thus respectfully submit that the requirements for a *prima facie* case for obviousness have not been met, and that the claims are not rendered obvious by these references.

Claims 6, 17, 36, and 73 are rejected under 35 U.S.C. §103(a) as being obvious over *Jasinschi* and *Narayanaswami* in view of *Beoglund* (US 2003/0101043). These claims are not rendered obvious by *Jasinschi* and *Narayanaswami* as discussed above. *Boeglund* does not make up for the deficiencies in *Jasinschi* and *Narayanaswami* with respect to these claims. *Boeglund* teaches a process for translating slides into another language, such as by saving text in the slide to an auxiliary file, such as a word processing file, and using a standard program to do the translation (paragraphs [0015]-[0022], [0041]-[0043]). *Boeglund* does not, however, teach or suggest comparing a presentation video to other external source documents in order to segment the presentation video in this process, determining whether a portion of the source document corresponds to a portion of the recorded information, such that a criterion is satisfied, and performing a determined action when the criterion is satisfied. As such, these claims cannot be rendered obvious by *Boeglund*, either alone or in any combination with *Jasinschi* and *Narayanaswami*.

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Claims 22-29, 52-59, and 78-82 are rejected under 35 U.S.C. §103(a) as being obvious over *Jasinschi, Narayanaswami*, and *Beogelund* in view of *Lin* (US 2004/0205477). These claims are not rendered obvious by *Jasinschi, Narayanaswami*, and *Beogelund* as discussed above. *Lin* does not make up for the deficiencies in *Jasinschi, Narayanaswami*, and *Beogelund* with respect to these claims. *Lin* teaches the creation of a browsable multimedia data object including a plurality of data streams corresponding to a presentation of information, in order to create a single, coherent recording of the real-time presentation that includes the slides, the presenter's interaction with the slides, and the audio of the presentation, which are simultaneously recorded during a presentation, for subsequent viewing by a user (paragraphs [0001], [0006], [0007], [0033]). The single multimedia data object includes the "plurality of synchronized overlaid replayable bitstreams" representing the real-time slide presentation (paragraph [0027]). The bitstreams within the object are synchronized so that when a slide is displayed, for example, the corresponding interaction is displayed and the corresponding audio is played (paragraphs [0029]-[0031]). *Lin* does not, however, teach or suggest comparing a presentation video to other external source documents in order to segment the presentation video in this process, determining whether a portion of the source document corresponds to a portion of the recorded information, such that a criterion is satisfied, and performing a determined action when the criterion is satisfied. As such, these claims cannot be rendered obvious by *Lin*, either alone or in any combination with *Jasinschi, Narayanaswami*, and *Beogelund*.

Claims 30, 60, and 83 are rejected under 35 U.S.C. §103(a) as being obvious over *Jasinschi, Narayanaswami, Beogelund*, and *Lin* in view of *Smith* (US 2004/0205601). These claims are not rendered obvious by *Jasinschi, Narayanaswami, Beogelund*, and *Lin* as discussed above. *Smith* does not make up for the deficiencies in *Jasinschi, Narayanaswami, Beogelund*, and *Lin* with respect to these claims. *Smith* teaches analyzing data files for hidden or embedded data and classifying / removing / resolving the hidden data in order to avoid security concerns with sharing the document, for example ([0063]-[0065]). *Smith* does not, however, teach or suggest comparing a presentation video to other external source documents in order to segment the presentation video in this process, determining whether a portion of the source document

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corresponds to a portion of the recorded information, such that a criterion is satisfied, and performing a determined action when the criterion is satisfied As such, these claims cannot be rendered obvious by *Smith*, either alone or in any combination with *Jasinschi*, *Narayanaswami*, *Beogelund*, and *Lin*.

Applicants therefore respectfully request that the rejections with respect to Applicants' claims 1-83 be withdrawn.

## VI.   Amendment to the Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,
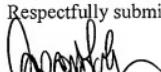
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